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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,547	10/08/1999	TOKIMORI TOMITA	122.1046-D/G	3462

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/414,547

Applicant(s)

TOMITA ET AL.

Examiner

Stefano Karmis

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*[Signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13-16, 19-23, 27, 31, 36, 38-49, 51 and 54-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13-16, 19-23, 27, 31, 36, 38-49, 51 and 54-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment Request for Continued Examination filed 13 November 2002.

#### ***Status of Claims***

2. Claim 1-4, 14-16, 19, 20, 22 have been amended. Claims 5-9, 11, 13, 21, 23, 27, 31, 36, 38, 39 are as originally filed. Claims 40-49, 51, 54-77 have been previously added. Therefore claims 1-9, 11, 13-16, 19-23, 27, 31, 36, 38-49, 51 and 54-77 are under prosecution in this application.

#### ***Allowable Subject Matter***

3. The indicated allowability of claims 1-9, 11-6, 19-23, 27, 31, 36, 38-77 is withdrawn in view of the newly discovered reference(s) to Schultz. Rejections based on the newly cited reference(s) follow.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-9, 11-6, 19-23, 27, 31, 36, 38-77 have been considered but are moot in view of the new ground(s) of rejection.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 6-8, 11, 22, 23, 27, 31, 38-42, 45, 51, 54, 56-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Schultz et al. (hereinafter Schultz) U.S. Patent 5,056,019.

Regarding independent claims 1 and 54, 56-63, Schultz discloses a point management system employing a computer for storing and managing points issued to each customer who receives service according to the issued points, comprising: point issue means for issuing the points to the customer according to transactions performed by the customer (column 6, lines 5-12); point accumulation means for calculating and accumulating the issued points for more than two transactions (column 6, lines 5-12); point notification means for notifying the customer of point information comprising the issued points (column 8, lines 48-63 and column 9, lines 25-38); customer identification means for identifying the customer according to customer identification information (column 7, lines 5-32); and wherein the point issue means comprises rate management means for changing a point calculation rate determined by predetermined transaction conditions in correspondence with each of the transactions according to each of the transactions (column 6, lines 5-12 and column 10, lines 44-52); and point notification means notifies the customer of the point information before the customer carries out the transaction

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(column 6, lines 54-64). Rate management is disclosed by awarding points based on volume of purchases. This encompasses different points for volume bundles, (i.e. 50 points for up to 100 products, 125 points for 200 products and so forth) because points are assigned based on volume (column 10, lines 44-52).

Claims 2 and 55, the point notification means notifies the customer of the point information as primary data through a customer terminal as soon as the customer terminal is turned on (column 9, lines 25-38).

Claim 3, the point notification means notifies the customer identified by the customer identification means of the point information as primary data through a store terminal (column 9, lines 25-38).

Claim 4, the point issue means includes rate management means for changing a point calculation rate according to purchase conditions (column 6, lines 5-12 and column 10, lines 44-52).

Claims 6-8, the rate management means changes the point calculation rate according to conditions set for purchases carried out at stores in a specific area or at a specific counter in a store, or a specific series of commodities or the number of purchase transactions carried out in a predetermined period (column 6, lines 5-12 and column 10, lines 44-52).

Claim 11 and 45, the point notification means notifies the customer of the point information in images, by voice or both (column 8, lines 48-63 and column 9, lines 25-38).

Claim 22, the point notification means uses available communication circuits to notify the customer of point information including target points for a service requested by the customer, the customer's cumulative points, or a shortage of points relative to the target points (column 9, lines 25-38).

Claim 23, the point accumulation means includes condition monitor means for changing accumulated points according to predetermined conditions (column 6, lines 5-12 and column 10, lines 44-52).

Claim 27, the service is provided to the customer through communication circuits (Figure 1).

Claim 31, the point information is supplied to the customer through the customer or store terminal through communication circuits (Figure 2).

Claim 38, the point accumulation means includes bonus points for attaining a predetermined volume (column 6, lines 5-12 and column 10, lines 44-52).

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Claim 39, pint accumulation required the customer to belong to a group (column 5, lines 44-56).

Claim 40, the point notification means notifies the customer of the point information as primary data of transaction (column 8, lines 48-63 and column 9, lines 25-38).

Claim 41, the point notification means notifies the customer of the point information in off-hours using communication circuits (column 8, lines 48-63 and column 9, lines 25-38).

Claim 42, the point notification means notifies the customer of the point information using a terminal and television display (column 8, lines 48-63 and column 9, lines 25-38).

Claim 51, the data processing means stores one of information of specific customers, information of groups, and information of specific customers and groups (column 7, lines 45-59).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 5, 9, 13-16, 19-21, 36, 43, 44, 46-49, and 64-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (hereinafter Schultz) U.S. Patent 5,056,019.

Claims 5, 9 and 67-77, Schultz teaches a point calculation based on volume of products purchased (column 6, lines 5-12 and column 10, lines 44-52). Schultz fails to teach point calculation based on predetermined times or number of accesses. Official Notice is taken that applying multiple criterion for point calculation is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the



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Applicant's invention to modify the teachings of Schultz and allow for point calculations based on predetermined times of number of access at a customer terminal because they are efficient criteria to measure to reflect a consumers shopping habits and thus use as a reference to assign points.

Claims 13-16 and 46-49, Schultz teaches a point notification means at a terminal and with a reward booklet to notify a customer of cumulative points and target points (column 6, lines 54-64 and column 8, lines 48-63. Schultz fails to teach point notification in a graph format, colors of brightness, or proportions. Official Notice is taken that graphical images to communicate account status are old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz and allow for point notification of cumulative points and target points in graphical format because it is an efficient manner to communicate the status of an account to a cardholder.

Claims 19-21, 43-44 and 64-66, Schultz teaches a notification means in which an in-store computer (column 9, lines 25-38). Schultz fails to specify that these in-store computers are attached to shopping cars and offer voice commands. Official Notice is taken that a shopping-cars equipped with a display screen is a form of an in-store computer. Therefore it would be obvious to one of ordinary skill in the art to modify the teachings of Schultz to include the in-store computers are attached to shopping carts because it provides quick access for consumers to gather account information.

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Claim 36, Schultz teaches a point calculation based on volume of products purchased (column 6, lines 5-12 and column 10, lines 44-52). Schultz fails to teach not disclosing the allocated points. Official Notice is taken that not notifying the customer of rewards is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz and allow for withholding point allocation because it allows the system to monitor account activity and to encourage the customer to continue purchasing.

### ***Conclusion***

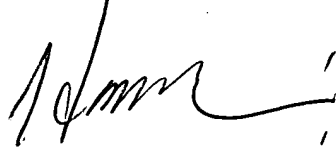
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
14 October 2004



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**